



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,144	02/21/2002	David Weldum	702_083	9288

20874 7590 02/25/2004  
WALL MARJAMA & BILINSKI  
101 SOUTH SALINA STREET  
SUITE 400  
SYRACUSE, NY 13202

EXAMINER

NGUYEN, LUONG TRUNG

ART UNIT	PAPER NUMBER
----------	--------------

2612

DATE MAILED: 02/25/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/080,144

Applicant(s)

WELDUM ET AL.

Examiner

LUONG T NGUYEN

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4,5,9,11,12,15,18,19,23,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-5, 9, 11-12, 15, 18-19, 23, 25-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's election without traverse of Group I, comprising Claims 1, 12, 15 and 26 in Paper No. 8 filed on 3/18/2003 is acknowledged.

The linking claims 4, 5, 9, 11, 18, 19, 23, 25, linking Groups I, II, II, will be examined along with elected Group I, comprising claims 1, 6, 12, 15 and 26.

Claims 2-3, 6-8, 10, 13-14, 16-17, 20-22, 24, 27-28 have been canceled by the Amendment filed on 12/08/2003.

### ***Claim Objections***

2. Claims 1, 4, 12, 19, 26 are objected to because of the following informalities:

Claim 1 (lines 4, 6), claim 19 (line 7), "said image file" should be changed to --said single image file--.

Claim 4 (line 2), "said system" should be changed to --said method--.

Claim 12 (lines 1-3), the limitation "wherein said image is obtained from a probe and said image-specific data includes measurement tip calibration data from said probe" is a repetitive limitation recited in claim 5 (lines 8-10).

Claim 26 (lines 2-3), the limitation "and said image-specific data includes measurement tip calibration data from said probe" is a repetitive limitation recited in claim 19 (lines 9-10).

Claims 23, 25-26 are objected as being dependent on claim 19.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5, 9, 11-12, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 (line 8) recites the limitation "said" in "said medium". There is insufficient antecedent basis for this limitation in the claim.

Claim 9 (lines 1-2) recites the limitation "said" in "said specific image transfer medium". There is insufficient antecedent basis for this limitation in the claim.

Claims 9, 11-12 are rejected as being dependent on claim 5.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4, 5, 9, 11-12, 15, 18-19, 23, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shahidi (US 2002/0077544) in view of Parulski et al. (US 6,310,647).

Regarding claim 15, Shahidi discloses a system for storing calibration data relating to at least one of an endoscope and a borescope (system 10, which has information relating to the pattern image seen by the endoscope in relation to endoscope position, direction, and orientation

Art Unit: 2612

is stored in an endoscope calibration data file 42 (figures 1-2, page [0028]), so that said data is retrievable by a custom application direct from said image file (the data in calibration data file 42 and image data in scan data file 38 are retrieved by computer 36, figures 1-2).

Shahidi fails to specifically disclose means for embedding data specific to a measurement system of said at least one of said endoscope and said borescope into said single image file, thereby allowing re-measurement using at least one of said endoscope and said borescope without using a separate image file for storing measurement system information. However, Parulski et al. discloses image file format, in which allows optional "ancillary" data to be stored in the same structure storage file, along with the image data, such as FlashPix file (column 1, lines 41-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Shahidi by the teaching of Parulski et al. in order to store image data and data information corresponding to image data in a single image data file format. Doing this, the time for retrieving image data and data information corresponding to image data is reduced.

Claim 1 is a method claim of apparatus claim 15. Therefore, claim 1 is rejected for the same reason given respect to apparatus claim 15.

Regarding claim 18, Shahidi discloses a system for storing image data and corresponding image and endoscope specific data, relating to at least one of an endoscope and a borescope (system 10, in which image data is stored in scan-data file 38, and information relating to the

Art Unit: 2612

pattern image seen by the endoscope in relation to endoscope position, direction, and orientation is stored in an endoscope calibration data file 42 (figures 1-2, page [0028]).

Shahidi fails to specifically disclose means for storing a combination of image data from said at least one of an endoscope and one or more of system calibration data, overlay replacement data, and audio comment data relating thereto in a single file of either a non-standard file format or a standard file format that does not explicitly support the inclusion of these data types. However, Parulski et al. discloses image file format, in which allows optional "ancillary" data to be stored in the same structure storage file, along with the image data, such as FlashPix file (column 1, lines 41-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Shahidi by the teaching of Parulski et al. in order to store image data and data information corresponding to image data in a single image data file format. Doing this, the time for retrieving image data and data information corresponding to image data is reduced.

Claim 4 is a method claim of apparatus claim 18. Therefore, claim 4 is rejected for the same reason given respect to apparatus claim 18.

Regarding claims 19, 26, 12, Shahidi discloses a system for storing, an image and image-specific data associated with said image, comprising means for obtaining said image (endoscopic surgical tool 16, figures 1-2, page 2, sections [0020], [0028]); means for obtaining said image-specific data (calibration tool 28, figures 1-2, page 2, section [0024]); means for choosing a specific image file format (calibration file 42, figures 1-2, page 2, section [0028]); means for

Art Unit: 2612

writing said image to said image file (volumetric scan data of the patient region of interest is stored in scan data file 38, figures 1-2, page 2, section [0028]).

Shahidi fails to specifically disclose storing, within a single image file using a selected file format, an image and image-specific data associated with said image; and means for writing said image-specific data to a marker in said selected file format wherein said image is obtained from a probe and said image-specific data includes measurement tip calibration data from said probe. However, Parulski et al. discloses image file format, in which allows optional “ancillary” data to be stored in the same structure storage file, along with the image data, such as FlashPix file (column 1, lines 41-65); and first application marker storing a first data value to convey a first information related to the image (column 3, lines 3-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Shahidi by the teaching of Parulski et al. in order to store image data and data information corresponding to image data in a single image data file format. Doing this, the time for retrieving image data and data information corresponding to image data is reduced.

Claim 5 is a method claim of apparatus claim 19. Therefore, claim 5 is rejected for the same reason given respect to apparatus claim 19.

Regarding claims 9, 23, Parulski et al. disclose wherein said selected file format is a JPEG file (JPEG file, column 3, lines 49-65).

Art Unit: 2612

Regarding claims 11, 25, Parulski et al. disclose means for determining if said image-specific data is contained in said single image file; means for retrieving the image-specific data from said single image file (car readers 50 in computer may be capable of reading FlashPix and JIF files (column 4, lines 5-16). FlashPix file contains the completed image and "ancillary" data (image-specific data), such as audio data, calibration data in the same file, column 1, lines 41-65). This shows that car readers 50 can determine if said image-specific data is contained in said image transfer medium and retrieve the image-specific data from the image transfer medium.

### *Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.




Art Unit: 2612

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUONG T NGUYEN whose telephone number is (703) 308-9297. The examiner can normally be reached on 7:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (703) 305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LN LN  
2/22/2004

  
WENDY R. GARBER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600